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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,715	09/24/1999	TOSHIHISA KUMAKURA	511.37656X00	8711

20457 7590 03/05/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/05/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/404,715

Applicant(s)

KUMAKURA ET AL.

Examiner

Judy M. R. ddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-14 and 20 is/are allowed.
- 6) ☒ Claim(s) 1,3-6,12-14 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 4 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 09/24/99 and considered by the Examiner on 09/19/01 has been initialed and is herein being resubmitted.

Claim Objections

2. Claims 4 and 8 are objected to because of the following informalities: In claim 4 @ line 2 and claim 8 @ line 7, "a polyvinyl acetal" should be deleted and "the polyvinyl acetal" should be inserted in its stead so as to engender claim language clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-6, 12-14 and 19-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cohen et al (U.S. 3,380,831).

Cohen et al disclose and exemplify photopolymerizable, adhesive compositions, useful for coating operations involving the use of a base substrate which includes those as described in U.S. patent 2,760,863 to Plambeck, Jr. such as aluminum foil, glass, wood, plastic, etc., wherein said photopolymerizable compositions are defined basically as

containing 1) a macromolecular polymer binder which includes thermoplastic polymer binders such as polyvinyl acetals and non-thermoplastic(thermosetting) polymer binders such as phenolic resins, melamine-formaldehyde resins etc., 2) an ethylenically unsaturated monomer capable of addition polymerization which include polyfunctional(meth)acrylate compounds, 3) a polymerization initiator and 4) other conventional adjutants which include fillers such as silica, dyes, pigments, etc. See, e.g., col. 1, lines 44-65 and cols. 9-11 of Cohen et al. Cohen et al therefore anticipate the instantly claimed invention with the understanding that the compositional constituents of Cohen et al overlap in scope with the compositional constituents, as claimed.

As to the claimed property limitations, it would be expected that the composition of Cohen et al would necessarily possess such since the adhesive composition of Cohen et al is essentially the same as the claimed adhesive composition. Applicant has the burden to show that this, in fact, is not the case(In re Best et al(195 USPQ 430)).

Conclusion

6. The additional prior art to Cohen et al(U.S. 3,594,410) cited on the attached PTO FORM 892 is cited as of interest in teaching adhesive compositions, similar to those of Cohen et al'831, and is considered merely cumulative. The remaining prior art reference U.S. 2,760,863 to Plambeck, Jr. is cited as evidence of disclosing metal substrates such as aluminum foil as the substrates used for the photopolymerizable compositions of Cohen et al.

Response to Arguments

7. Applicant's arguments filed on 02/10/03 have been considered. However, said arguments do not address the prior art rejection at hand.

Allowable Subject Matter

8. Claims 7-11, 12-14/7-11 and 20/7 are deemed allowable over the prior art f record including that of Cohen et al(U.S. 3,380,831), meritorious of the closest prior art, as per said art

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neither anticipating nor rendering obvious the precisely defined epoxy resin-governed adhesive composition, as claimed. One having ordinary skill in the art would not have been endowed with any motivation to extrapolate the precisely defined epoxy resin-governed adhesive composition from the disclosure of Cohen et al with any reasonable expectation of success. Claims 7-11 are allowed.

Response to Amendment

9. *The amendment to the claims filed on 02/10/03 has been carefully considered and entered. After a further review of the file coupled with an updated search, new art has come to the Examiner's attention and a rejection based upon such is deemed proper and is as set forth supra. Accordingly, prosecution on the merits is herein reopened. The Examiner extends an apology to applicants for any inconvenience that this may have caused.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
February 26, 2003